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JONES DAY
222 EAST 41ST STREET
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In re Application of	:	
AEBI, Max et al.	:	
Application No.: 10/539,660	:	DECISION ON
PCT No.: PCT/CH02/00705	:	
Int. Filing Date: 17 December 2002	:	PETITION
Priority Date: None	:	
Attorney Docket No.: LUS-16090	:	UNDER 37 CFR 1.47(a)
For: INTERVERTEBRAL IMPLANT	:	
WITH TILTABLE JOINT PARTS	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 14 September 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 17 December 2002, applicants filed international application PCT/CH2002/000705. A copy of the international application was communicated from the International Bureau to the USPTO on 01 July 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 June 2005.

On 14 June 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 14 February 2006, the Office mailed a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 14 September 2006, applicants filed the instant petition under 37 CFR 1.47(a), accompanied by the fee for a five month extension of time and a declaration of inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1) and (4) have been satisfied.

Item (2) has not been satisfied. Applicants allege that Mr. Aebe has refused to sign the declaration of inventorship, but have not established that the inventor was presented with a complete copy of the application papers including the specification, claims and drawings. Ordinarily, this is done by sending a complete copy of the papers to inventor's last known residence by return receipt mail. Copies of documentary evidence supporting a presentation with a complete copy of the application papers should be provided. MPEP 409.03(d). The email delivery receipt confirms delivery of the email, not receipt. A refusal to sign in the absence of presentation with a complete copy of the application papers is not ordinarily sufficient.

Mr. Tuma states that Mr. Aebe was refusing to sign any papers related to the above-identified patent application as of 10 August 2005. As earlier indicated, refusal to sign in the absence of presentation with a complete copy of the application papers is not normally sufficient. Additionally, it is not clear that the author of the 10 August 2005 letter to Mr. Spaw has firsthand knowledge of the alleged refusal. Further, transfer of ownership rights is not required for Mr. Aebe to sign the declaration of inventorship.

Item (3) has not been satisfied. The last known address of a non-signing inventor is ordinarily the last known residence of the non-signing inventor. MPEP 409.03(e). The address provided for Mr. Aebe is a business address.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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